



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of

TOMKA et al.

Examiner: P. Nordmeyer

Serial No.: 09/606,219

Art Unit: 1772

Filed: June 29, 2000

For: **A METHOD FOR MANUFACTURING A SHAPE BODY CONTAINING
A STARCH, A HOMOGENISED MASS CONTAINING STARCH AND
A DEVICE FOR MANUFACTURING A SOFT CAPSULE**

TRANSMITTAL LETTER

Commissioner for Patents
Washington, D.C. 20231

RECEIVED
APR 25 2002
TC 1700

Sir:


Submitted herewith for filing in the U.S. Patent and Trademark Office is the following:

- (1) Transmittal Letter; and
- (2) Response to Restriction Requirement.

The Commissioner is hereby authorized to charge any deficiency or credit any excess to Deposit Account No. 14-0112.

Respectfully submitted,

NATH & ASSOCIATES PLLC


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PATENT

Attorney Docket No. 24301

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RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

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Sir:

This is in response to the Official Action dated March 25, 2002. The one-month shortened statutory period for response is set to expire April 25, 2002. Accordingly, this Response is filed within the period for reply set by the Examiner.

SUMMARY OF RESTRICTION REQUIREMENT

The Examiner has required restriction of claims 1-22 under 35 U.S.C. 121 to a single invention encompassed by the claims as follows:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, drawn to a method for manufacturing a shape body containing a starch, classified in class 264.
- II. Claims 12-21, drawn to a homogenized starch-containing mass, classified in class 428 subclass 35.2.
- III. Claim 22, drawn to a device for manufacturing a soft capsule, classified in class 53, subclass 900.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I, claims 1-11 and Group II, claims 12-21 are related as process of making and product made. The inventions are distinct of either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as sending the mixture through a pair of embossed nip rollers to form a continuous film that has been reshaped in a set pattern.

Inventions Group I, claims 1-11 and Group III, claim 22 are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another materially different process. (MPEP § 806.05(e)). In this case the process claimed can be practiced by another and materially different apparatus such as a pair of embossed nip rollers.

Inventions Group III, claim 22 and Group II, claims 12-21 are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product can be made by a materially different apparatus such as a pair of embossed nip rollers to reshaped the formed film with a set pattern.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, different modes of operation, different functions, different effects and their divergent subject matter, restriction for examination purposes as indicated is proper.

Applicants is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or

more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

ELECTION

Applicants provisionally elect Group II, claims 12-21, drawn to a homogenized starch-containing mass, with traverse.

TRAVERSAL

Applicants respectfully traverse the Examiner's restriction requirement for the following reasons.

Applicants respectfully request the Examiner to recombine Groups I, II, and III. The restriction requirement is improper since the classes and subclasses recited by the Examiner for each of these Groups are all assigned to the Examiner's art unit. Given their overlapping subject matter and identical classifications, examinations of all the invention Groups would not pose a serious burden because they would be coextensive.

At a minimum, applicants respectfully request the Examiner to partially rejoin Groups I and III to provisionally elected Group II insofar as they claim a method for manufacturing the product of Group II and a device for manufacturing the product of Group II, respectively. The Examiner has admitted that the invention of

Group I would be distinct from the invention of Group II only if it can be shown that the process as claimed can be used to make another and materially different product; accordingly, applicants respectfully request the Examiner to rejoin Group I only as it relates to a process for preparing the homogenized starch-containing mass of Group II. Similarly, the Examiner has admitted that the invention of Group III would be distinct from the invention of Group II if it can be shown that the apparatus as claimed can be used for making a different product; accordingly, applicants respectfully request the Examiner to rejoin Group III only as it relates to an apparatus for preparing the homogenized starch-containing mass of Group II. If partially rejoined as requested, the separate Groups identified by the Examiner are connected to each other since they relate to 1) the product *per se*; 2) a method of manufacturing the specific product; and 3) to the device for carrying out the specific method.

Finally, applicants have paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when this application was filed, applicants must pay duplicative fees to file divisional applications for the non-elected or withdrawn groups of claims.

CONCLUSION

In view of the foregoing, applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement and

to examine claims 1-22 pending in this application.

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,

NATH & ASSOCIATES PLLC


Date:

April 23, 2002

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